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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,425	05/18/2001	Chi-Thanh Dang	109444	3704

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EXAMINER

SMITH, PETER J

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,425

Applicant(s)

DANG ET AL.

Examiner

Peter J Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. This action is responsive to communications: application filed on 5/18/2001.
2. Claims 1-21 are pending in the case. Claims 1, 6, 11, 16, and 21 are independent claims.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claim 21 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 21 is directed towards a “carrier wave” which is non-statutory because it does not fit into any of the three statutory product classes because it is non-physical. See MPEP §2106:

For the purposes of a 35 U.S.C. 101 analysis, it is of little relevance whether the claim is directed to a machine or a process. The legal principles are the same. *AT &T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1357, 50 USPQ2d 1447, 1451 (Fed. Cir. 1999).

(a) Statutory Product Claims

Products may be either machines, manufactures, or compositions of matter.

A *machine* is “a concrete thing, consisting of parts or of certain devices and combinations of devices.” *Burr v. Duryee*, 68 U.S. (1 Wall.) 531, 570 (1863).

A *manufacture* is “the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties or combinations, whether by hand labor or by machinery.” *Chakrabarty*, 447 U.S. at 308, 206 USPQ at 196-97 (quoting *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1, 11 (1931)).

A *composition of matter* is “a composition of two or more substances [or] . . . a[] composite article, whether [it] be the result[] of chemical union, or of mechanical mixture, or whether . . . [it] be [a] gas[], fluid[], powder[], or solid[].” *Id.* at 308, 206 USPQ at 197 (quoting *Shell Development Co. v. Watson*, 149 F. Supp. 279, 280, 113 SPQ 265, 266 (D.D.C. 1957), *aff’d per curiam*, 252 F.2d 861, 116 USPQ 428 (D.C. Cir. 1958)).

If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. See, e.g., *Lowry*, 32 F.3d at 1583, 32 USPQ2d at 1034-35; *Warmerdam*, 33 F.3d at 1361-62, 31 USPQ2d at 1760. Office personnel must treat each claim as a whole. The mere fact that a hardware element is recited in a claim

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does not necessarily limit the claim to a specific machine or manufacture. Cf. *In re Iwahashi*, 888 F.2d 1370, 1374-75, 12 USPQ2d 1908, 1911- 12 (Fed. Cir. 1989), cited with approval in *Alappat*, 33 F.3d at 1544 n.24, 31 USPQ2d at 1558 n.24.

A claim limited to a machine or manufacture, which has a practical application in the technological arts, is statutory. In most cases, a claim to a specific machine or manufacture will have a practical application in the technological arts. See *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557 (“the claimed invention as a whole is directed to a combination of interrelated elements which combine to form a machine for converting discrete waveform data samples into anti-aliased pixel illumination intensity data to be displayed on a display means. This is not a disembodied mathematical concept which may be characterized as an abstract idea,’ but rather a specific machine to produce a useful, concrete, and tangible result.”); and *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601 (“the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces a useful, concrete and tangible result’ – a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.”). Also see *AT & T*, 172 F.3d at 1358, 50 USPQ2d at 1452 (Claims drawn to a long-distance telephone billing process containing mathematical algorithms were held patentable subject matter because the process used the algorithm to produce a useful, concrete, tangible result without preempting other uses of the mathematical principle.).

The three statutory product classes have traditionally required physical structure or matter. The claimed carrier wave has no physical structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a machine. The claimed carrier wave is not matter, but a form of energy, and therefore is not a composition of matter. A manufacture can be an article produced from raw or prepared materials by manipulating the raw or prepared materials. A manufacture is also defined as the residual class of product. That the other two product classes, machine and composition of matter, require physical matter is evidence that a manufacture was also intended to require physical matter. Thus, the Examiner concludes that the claimed carrier wave is not one of the three statutory product classes.

5. Additionally, independent claim 21 is directed towards a “control program usable for managing dynamic translation to a device for executing the control program” to perform instructions. As presently drafted, the claim reads on a computer program per se, which does not

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constitute statutory subject matter as prescribed under 35 USC §101. Applicant could easily render the claimed invention statutory by amending the preamble to recite “A control program stored on a computer readable medium”. The language in the preamble “A carrier wave encoded” with the control program does not render the claim statutory because a carrier wave is not a computer readable medium.

The language in the preamble, “usable for managing dynamic translation to a device for executing the control program” does not render the claimed invention statutory because it in effect constitutes intended use. See MPEP §2106:

The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined. As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

Therefore, the intended use language does not limit the claim, and cannot be given patentable weight or a cause for the preamble to be statutory. For these two reasons set forth in this and the preceding paragraph 4, independent claim 21 is found by the Examiner to be non-statutory under 35 U.S.C. 101.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

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subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Tso et al. (hereinafter "Tso"), US 6,421,733 B1 filed 9/8/1997.

Regarding independent claim 1, Tso discloses a client language storage for storing language information associated with a client and a user in col. 8 lines 41-45. Tso discloses a skeleton determining circuit for determining at least one skeleton content elements of a received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser determines which elements need to be dynamically transcoded. Tso discloses a language storage table for storing at least one translation of each of at least one skeleton content elements based on the skeleton content element and a language in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements. Tso discloses a client and user determining circuit for determining a client and a user associated with a content portion in col. 8 lines 41-45. Tso discloses a merging circuit for merging at least one skeleton content elements based on the language associated with the determined client into the received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies which content elements need to be dynamically transcoded and replaces the identified content elements with the appropriate translation. Content elements which do not require a translation, such as a graphic element, are maintained by the parser and recombined with the translated elements forming a merging of the translation into the content portion.

Regarding dependent claim 2, Tso discloses wherein the language table storage generates translated skeleton content elements using dynamic natural language translation in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso dynamically transcodes skeleton content elements identified by the parser from one natural language to another according to the embodiment described in col. 8 lines 41-50 thus implementing dynamic natural language translation.

Regarding dependent claim 3, Tso discloses wherein the client and user determining circuit determines at least one of a client identification and a user identification based on at least one of internet protocol address information, session identifier information, name pairs/value pairs and attribute/value pairs in col. 8 lines 41-45.

Regarding dependent claim 4, Tso discloses wherein the merged content portions are stored using at least one of an electronic medium; a printed medium and a paper medium in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding dependent claim 5, Tso discloses wherein the merged content portions are at least one of an interactive electronic text, a printed text, an audio book, and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding independent claim 6, Tso discloses receiving a content portion from a client in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso discloses determining at least one of a client and a user associated with the content portion in col. 8 lines 41-45. Tso discloses determining at least one skeleton content elements of the received content portion in fig. 3, col. 3

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line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser determines which elements need to be dynamically transcoded. Tso discloses determining at least one translated skeleton content elements from a language table based on the determined at least one client and user in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements. Tso discloses merging the at least one translated skeleton content elements into the content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies which content elements need to be dynamically transcoded and replaces the identified content elements with the appropriate translation. Content elements which do not require a translation, such as a graphic element, are maintained by the parser and recombined with the translated elements forming a merging of the translation into the content portion.

Regarding dependent claim 7, Tso discloses wherein the translated skeleton content elements are determined using at least one of dynamic natural language translation and language table look up in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso dynamically transcodes skeleton content elements identified by the parser from one natural language to another according to the embodiment described in col. 8 lines 41-50 thus implementing dynamic natural language translation. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be

performed by some form of table to match the foreign language elements to the corresponding native language text elements.

Regarding dependent claim 8, Tso discloses wherein the client and user is determined based on at least one of internet protocol address information, session identifier information, name pairs and value pairs in col. 8 lines 41-45.

Regarding dependent claim 9, Tso discloses wherein determining the merged content portions produces at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding dependent claim 10, Tso discloses wherein the merged content portions are stored on at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding independent claim 11, Tso discloses receiving a content portion from a client in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso discloses determining at least one of a client and a user associated with the content portion in col. 8 lines 41-45. Tso discloses determining at least one skeleton content elements of the received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser determines which elements need to be dynamically transcoded. Tso discloses determining at least one translated skeleton content elements from a language table based on the determined at least one client and user in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be

dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements. Tso discloses merging the at least one translated skeleton content elements into the content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies which content elements need to be dynamically transcoded and replaces the identified content elements with the appropriate translation. Content elements which do not require a translation, such as a graphic element, are maintained by the parser and recombined with the translated elements forming a merging of the translation into the content portion.

Regarding dependent claim 12, Tso discloses wherein the translated skeleton content elements are determined using at least one of dynamic natural language translation and language table look up in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso dynamically transcodes skeleton content elements identified by the parser from one natural language to another according to the embodiment described in col. 8 lines 41-50 thus implementing dynamic natural language translation. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements.

Regarding dependent claim 13, Tso discloses wherein the client and user is determined based on at least one of internet protocol address information, session identifier information, name pairs and value pairs in col. 8 lines 41-45.

Regarding dependent claim 14, Tso discloses wherein determining the merged content portions produces at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding dependent claim 15, Tso discloses wherein the merged content portions are stored on at least one of an interactive text, a printed text, an audio book and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding independent claim 16, Tso discloses a client language storage for storing language information associated with a client and a user in col. 8 lines 41-45. Tso discloses a skeleton determining circuit for determining at least one skeleton content elements of a received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser determines which elements need to be dynamically transcoded. Tso discloses a language storage table for storing at least one translation of each of at least one skeleton content elements based on the skeleton content element and a language in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements. Tso discloses a client and user determining circuit for determining a client and a user associated with a content portion in col. 8 lines 41-45. Tso discloses a merging circuit for merging at least one skeleton content elements based on the language associated with the determined client into

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the received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies which content elements need to be dynamically transcoded and replaces the identified content elements with the appropriate translation. Content elements which do not require a translation, such as a graphic element, are maintained by the parser and recombined with the translated elements forming a merging of the translation into the content portion.

Regarding dependent claim 17, Tso discloses wherein the language table storage generates translated skeleton content elements using dynamic natural language translation in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso dynamically transcodes skeleton content elements identified by the parser from one natural language to another according to the embodiment described in col. 8 lines 41-50 thus implementing dynamic natural language translation.

Regarding dependent claim 18, Tso discloses wherein the client and user determining circuit determines the client and user identifier based on at least one of internet protocol address information, session identifier information and name and value pairs in col. 8 lines 41-45.

Regarding dependent claim 19, Tso discloses wherein the merged content portions are stored using at least one of an electronic media; a printed media and a paper media in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding dependent claim 20, Tso discloses wherein the merged content portions are at least one of an interactive electronic text, a printed text, an audio book, and a video book in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The merged content portions of Tso are stored as a web page, which can also be printed out by the client.

Regarding independent claim 21, Tso discloses carrier wave encoded to transmit a control program usable for managing dynamic translation to a device for executing the control program. Tso discloses receiving a content portion from a client in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. Tso discloses determining at least one of a client and a user associated with the content portion in col. 8 lines 41-45. Tso discloses determining at least one skeleton content elements of the received content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser determines which elements need to be dynamically transcoded. Tso discloses determining at least one translated skeleton content elements from a language table based on the determined at least one client and user in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies content elements requiring transcoding. Tso discloses in col. 8 lines 41-50 that the elements may be dynamically transcoded from one language to client or user's preferred language. The translation of the elements must be performed by some form of table to match the foreign language elements to the corresponding native language text elements. Tso discloses merging the at least one translated skeleton content elements into the content portion in fig. 3, col. 3 line 31 – col. 4 line 37, and col. 8 lines 41-50. The parser identifies which content elements need to be dynamically transcoded and replaces the identified content elements with the appropriate translation. Content elements which do not require a translation, such as a graphic element, are maintained by the parser and recombined with the translated elements forming a merging of the translation into the content portion.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldberg et al., US 6,161,082 filed 11/18/1997 discloses a network based language translation system. Atkin et al., US 6,490,547 B1 filed 12/7/1999 discloses dynamic localization of software at run time. Hamann, US 6,092,036 filed 6/2/1998 discloses a multilingual data processing system which can operate in a source language and one or more target languages by automatically translating text. Kobayakawa et al., US 6,119,078 filed 10/13/1997 discloses automatically translating Web pages. Hiroya et al., US 5,751,957 patented 5/12/1998 discloses a communication service system employing translation rules for communicating data in different languages along a network. Lakritz, US 6,623,529 B1 filed 6/28/1999 discloses multilingual electronic document translation, management and delivery. Kurachi et al., US 6,092,035 filed 12/3/1997 discloses a multilingual transmission system. Bourbonnais et al., US 6,338,033 B1 filed 4/20/1999 discloses a network-based teletranslation system for translating documents from one natural language to another natural language. Hayashi et al., US 6,321,188 B1 filed 10/16/1995 discloses an interactive system providing language information for communication between users of different languages. Atkin et al., US 6,492,995 B1 filed 4/26/1999 discloses enabling localization support on Web applications.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter J Smith whose telephone number is 703-305-5931. The examiner can normally be reached on Mondays-Fridays 7:00am-3:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph H Feild can be reached on 703-305-9792. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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PJS

September 1, 2004



SANJIV SHAH
PRIMARY EXAMINER